

REMARKS

[0001] The following paragraphs are numbered for ease of future reference. Entry of this Amendment is proper since no new issues are being raised which would require the Examiner's further consideration and/or search.

[0002] The following paragraphs are numbered for ease of future reference. Claims 16-17 and 30-31 are all the claims presently pending in this application. Claims 16 and 30 have been amended to further clarify the claimed invention.

[0003] Applicant further respectfully submits that no new matter is added to the currently amended claims, nor has the scope of the pending claims changed in that the amendments to the claims merely move previous language to further clarify certain claimed elements. Applicant respectfully traverses the rejections based on the following discussion.

I. OBJECTION TO THE CLAIMS

[0004] Claims 16 and 30 are objected to due to informalities. Applicant notes that this rejection was made on December 19, 2008 and that Applicant previously corrected the typographical error of, "if-then-else-rules" in Applicant's response submitted February 19th, 2009. The Examiner is respectfully requested to reconsider and withdraw this erroneous objection.

II. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

[0005] Claims 16 and 30 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 16 and 30 have been amended in a manner believed fully responsive to all points raised by the Examiner. More specifically, claims 16 and 30 have been amended to delete the language, "to be". In view of the foregoing, the Examiner is respectfully requested to

reconsider and withdraw this rejection.

III. THE PRIOR ART REJECTION

The 35 U.S.C. § 103(a) Rejection over Zambo further in view of McCollum, Bigus and AAPA

[0006] Claims 16-17 and 30-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zambo et al., U.S. Pat. No. 6,985,907, (hereinafter “Zambo”), further in view of McCollum et al., U.S. Pat. App. Pub. No. 2005/0091640, Bigus et al., U.S. Pat. No. 7,136,843 and further in view of Applicant’s Admitted Prior Art, (hereinafter “McCollum, Bigus and AAPA”).

[0007] The Examiner alleges that one of ordinary skill in the art would have been motivated to modify Zambo with the teaching from McCollum, Bigus and AAPA to form the invention of claims 16-17 and 30-31. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0008] Applicant traverses the Examiner’s rejection since, among other reasons, Zambo is directed toward inputting a text comment associated with the field claim, inputting a plurality of condition codes and at least four keyword combinations of at least two non-sequential keywords for each condition code, and for each condition code, attributing the condition code as an applicable condition code if at least one keyword combination for the condition code is included in the text comment. However, Applicant’s claimed invention is directed toward selecting a rules system including a plurality of codes comprising natural language text of laws, policy statement, contract provisions, agreements, regulations, rules of association, constitutions, or codes of conduct, and mapping said codes to target rules by transforming a logical structure of

said codes to target rules using grammar and syntax of said natural language text.

[0009] More specifically, Applicant submits, that neither Zambo, nor McCollum, Bigus and AAPA, nor any alleged combination thereof, teaches or suggests:

“selecting a rules system by a computer, said rules system including a plurality of codes comprising natural language text of one of laws, policy statement, contract provisions, agreements, regulations, rules of association, constitutions, and codes of conduct, wherein said codes are represented in a form corresponding to a particular type of analysis performed on said codes, and said rules system includes one of fuzzy rules, if-then-else-rules and declarative rules,”

and

“mapping said codes to automatically create target rules representing said codes based on said selected rules system by said computer, by transforming a logical structure of said codes to target rules using grammar and syntax of said natural language text of said selected rules system,” of Applicant’s independent claim 16, and similarly, independent claim 30.

[0010] The examiner on page the 5 of the After-Final Office action admits that “Zambo, McCollum and Bigus do not explicitly teach types of codes.” However, the examiner alleges that applicant’s specification at paragraph [0002] is equivalent to “admitted prior art.” Applicant respectfully traverses the examiner’s allegation that applicant’s Specification at paragraph [0002] is “applicant’s admitted prior art.” Applicant’s Specification at paragraph [0002] merely defines the term “code,” within the context of applicant’s claimed invention:

The term code, and codified provisions, is used herein to refer to any set of formalized statements of conduct of individuals or legal entities, such as corporations. Such codes may be laws, such as those of civil or criminal justice, international laws, policy statements, contract provisions, agreements, regulations, rules of association, constitutions, codes of conduct, and so on.

[0011] The examiner, upon admission that the cited prior art references fail to “explicitly teach

types of codes" equivalent to applicant's claimed invention attempts to erroneously use
Applicant's disclosure in the Specification against the applicant's claimed invention.

[0012] Furthermore, Applicant respectfully submits that Zambo would not have been combined with Applicant's Specification at paragraph [0002] as alleged by the Examiner. Indeed, the reference to Zambo and Applicant's Specification at paragraph [0002] are non-analogous because they are completely unrelated. Zambo is directed toward inputting a text comment associated with the field claim, inputting a plurality of condition codes and at least four keyword combinations of at least two non-sequential keywords for each condition code, and for each condition code, attributing the condition code as an applicable condition code if at least one keyword combination for the condition code is included in the text comment.

[0013] While Applicant's Specification at paragraph [0002] defines the term "code" in the context of Applicant's claimed invention as "code, and codified provisions, is used herein to refer to any set of formalized statements of conduct of individuals or legal entities, such as corporations. Such codes may be laws, such as those of civil or criminal justice, international laws, policy statements, contract provisions, agreements, regulations, rules of association, constitutions, codes of conduct." This definition of "code" of the present invention is completely different to the "codes" disclosed Zambo are directed.) No person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

[0014] In fact, Applicant submits that the Examiner can point to no proper motivation or suggestion in the reference or of one of ordinary skill in the art to urge the combination as alleged by the Examiner. Zambo discloses that the condition codes "(CC)" for tire/vehicle component conditions are alphanumeric codes that identify certain ordered conditions of a particular vehicular component. See Table 1 and column 4. Applicant's "codes" may be "laws, such as

those of civil or criminal justice, international laws, policy statements, contract provisions, agreements, regulations, rules of association, constitutions, codes of conduct,” in natural language text, complete different from mere alphanumeric codes representing a particular condition.

[0015] The Examiner’s alleged motivation to combine these two disparate concepts is that the disclosure of Applicant’s Specification at paragraph [0002] “would have allowed Zambo’s method to improve using codes,” where the Examiner further cites Applicant’s Specification at paragraph [0005], that states, “A need exists for an improved manner of using codes in view of these and other observations.” However, the “codes” of Applicant’s Specification at paragraph [0005] are describing “codes” related to “laws, such as those of civil or criminal justice, international laws, policy statements, contract provisions, agreements, regulations, rules of association, constitutions, codes of conduct,” as enumerated in Applicant’s Specification at paragraph [0002], and not “conditions codes” of Zambo’s Table 1. Nowhere is there any disclosure in Zambo or any other cited prior art reference that teaches modifying/substituting the “condition codes” of Zambo with Applicant’s claimed, “codes comprising natural language text.”

[0016] Thus, the Examiner’s allegation of combining that “would have allowed Zambo’s method to improve using codes,” “is a complete hindsight reasoning attempt to modify the cited prior art reference to Zambo with a concept having no equivalence to one another other than the use of the term, “code.” Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner.

[0017] Furthermore, Zambo fails to teach or suggest, “transforming a logical structure of said codes to target rules using grammar and syntax of said natural language text of said selected

rules system." The Examiner alleges that Fig. 2, col 4, lines 45-61 and Table 2, col. 6, lines 65-67 of Zambo disclose this portion of Applicant's claimed invention, but nowhere in these citations made by the Examiner, nor anywhere else in Zambo, nor anywhere in the remaining cited prior art is there any disclosure of transforming a logical structure of codes comprising natural language...using grammar and syntax of the natural language text.

[0018] McCollum and Bigus fail to overcome the deficiencies of Zambo as discussed above, and as admitted by the Examiner on the bottom of page 5 of the After-Final Office Action.

[0019] In summary, Zambo is directed toward inputting a text comment associated with the field claim, inputting a plurality of condition codes and at least four keyword combinations of at least two non-sequential keywords for each condition code, and for each condition code, attributing the condition code as an applicable condition code if at least one keyword combination for the condition code is included in the text comment. However, Applicant's claimed invention is directed toward *selecting a rules system including a plurality of codes comprising natural language text of laws, policy statement, contract provisions, agreements, regulations, rules of association, constitutions, or codes of conduct, and mapping said codes to automatically create target rules by transforming a logical structure of said codes to target rules using grammar and syntax of said natural language text.*

[0020] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Zambo and McCollum, Bigus and AAPA (either alone or in combination) fail to teach or suggest each element and feature of Applicant's claimed invention.

IV. FORMAL MATTERS AND CONCLUSION

[0021] In view of the foregoing, Applicant submits that claims 16-17 and 30-31, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

[0022] Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic interview.

[0023] The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Respectfully Submitted,

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